

Application No. 09/963,989
Amendment "A" dated December 2, 2005
Reply to Office Action mailed September 14, 2005

BEST AVAILABLE COPY**REMARKS**

The Office Action, mailed September 14, 2005, considered claims 1-36. Claims 1, 9-16, 20, 26, 28 and 32 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4, 8-16 and 20-24, 26, 27 and 28-36 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ayabe et al. (U.S. Patent No. 6,868,274) in view of Havinis, et al. (U.S. Patent No. 6,516,197). Claims 5-7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ayabe et al, in view of Havinis et al, as applied to the claims above, and further in view of Mathon et al. (U.S. Publication No. 2001/0042131). Claims 17-19 and 25 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.¹

By this paper, claims 1, 17, 20, 25, 26-28 and 32 have been amended, claims 37 and 38 have been added, and no claims have been cancelled.² Accordingly, following this paper, claims 1-38 remain pending, of which claims 1, 17, 20, 25, 26, 28 and 32 are the only independent claims at issue.

Initially, Applicants note that the preambles of claims 1, 20, 26, 28 and 32 have been amended to overcome the rejection under 35 U.S.C. § 112, second paragraph, and that claims 17 and 25 have been rewritten in independent form, incorporating all limitations of any prior base claims. In light of the amendments, as reflected above, Applicants respectfully submit that the rejection has been overcome.³

¹ Although the prior art status and some of the assertions made with regard to the cited art is not being challenged at this time, inasmuch as it is not necessary following the amendments and remarks made herein, which distinguish the claims from the art of record, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art, as well as any official notice, which was taken in the last office action, at any appropriate time in the future, should the need arise, such as, for example in a subsequent amendment or during prosecution of a related application. Accordingly, Applicants' decision not to respond to any particular assertions or rejections in this paper should not be construed as Applicants acquiescing to said assertions or rejections.

² Support for the claim amendments and new claims may be found in paragraphs [0018], [0019] and [0061]-[0067], as well as in other locations within the Applicants' originally filed application. Accordingly, Applicants respectfully submit that the claim amendments do not add new matter.

³ Claims 17-19 and 25 are in condition for allowance as they were previously found to have patentable subject matter. Additionally, although the preambles to claims 1, 20, 26, 28 and 32 have been amended, Applicants do not necessarily agree with the assertions made in the Office Action. In particular, Applicants do not necessarily acquiesce that the amendments were made to claim limitations inasmuch as such amendments were made only to preambular recitations.

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As noted above, claims 9-16 were rejected under 35 U.S.C. § 112, second paragraph as indefinite, inasmuch as they recited "Standards of TDMA, CDMA, UMTS, GSM, etc" which are "subject to being changed." Applicants respectfully traverse.

In determining whether a claim meets the threshold requirements for definiteness, and thus complies with 35 U.S.C. § 112, second paragraph, the inquiry is centered on whether the claim, as a whole apprises one of ordinary skill in the art of its scope. M.P.E.P. § 2173.02. Further, as recently reiterated by the United States Court of Appeals for the Federal Circuit, the appropriate timing for such an inquiry is "at the time of invention, i.e., as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005). In other words, if, at the time the present application was filed, the recited standards were determinable by one of ordinary skill in the art, the claims do not fail for a lack of definiteness.

Applicants respectfully note that numerous issued patents exist and which claim specific cellular telephone technology standards. For example, U.S. Patent No. 6,826,400, entitled, "Method and Apparatus for Concurrent Monitoring of Divergent Wireless Telecommunication Systems" was issued to Cashman et al. on November 30, 2004 following Appeal No. 2001-1563 to the Board of Patent Appeals and Interferences, and claims specific communication system specifications. During prosecution of the application leading to the '400 patent, a claim directed to a "communication system conform[ing] with the IS-136 specification," was specifically rejected based on 35 U.S.C. § 112, second paragraph, because "specifications and standards change over time." During an appeal to the Board, the panel unanimously reversed the indefiniteness rejection. *Ex parte Cashman*, Appeal No. 2001-1563, Appl. No. 09/151,580 (Bd. Pat. App. & Int. 2004) (non-precedential). In particular, the Board held that if a recited standard is determinable *at the time of filing*, the claim is definite. *Id.* ("the claimed IS-136 specification was determinable at the time of filing, and thus is definite).

Although *Ex parte Cashman* is non-precedential, Applicants submit that it is directly on point to the present application, and fully in-line with the clearly established precedent reiterated by the Federal Circuit in *Phillips v. AWH Corp.* Accordingly, Applicants respectfully submit that the holdings in both *Ex parte Cashman* and *Phillips v. AWH Corp.* are applicable to the present invention and, because the cellular network technologies recited in claims 9-16 of the present invention were determinable at the time of filing, any future change to such standard are irrelevant to determining claim definiteness. Accordingly, for at least these reasons Applicants

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respectfully request that the rejection to claims 9-16, under 35 U.S.C. § 112, second paragraph, be withdrawn.

With respect to the rejections under 35 U.S.C. § 103(a), Applicants respectfully submit that the claims, particularly as amended, overcome the rejections of record.

Applicants' invention, as claimed for example in independent claim 1, relates to facilitating transmission of multi-part messages between cellular computing devices. In the recited method, a function call is received from a calling application via a standardized user interface, the function call requesting transmission of a first message over a cellular network. Thereafter, the first message is divided into a set of short message fragments of limited size, and each of the fragments is transmitted over the cellular network. As clarified by amendment, the calling application from which the function call is received, is further capable of acting as a receiving application for a second message which is reassembled from a second set of short message fragments.

Applicants' invention, as claimed in independent claims 20 and 26 are related to the foregoing method, but recited as a computer program product (claim 20), or in functional (step for) language (claim 26). Applicants' invention, as claimed for example in independent claims 28 and 32 is directed to a method (claim 28) and computer program product (claim 32) in which a receiving application receives a multi-part message reassembled from multiple short message fragments. In the method, a plurality of short message fragments are received and reconstructed into the multi-part message. Thereafter, the reassembled message is passed to the receiving application via a standardized interface. As clarified by amendment, the receiving application is further adapted to act as a calling application for a second multi-part message.

Although Ayabo and Havinis appear to generally relate to systems, methods, and devices for sending messages in a cellular telecommunication system, Applicants respectfully submit that the cited art fails to teach or suggest the claimed invention. For example, the cited art fails to teach or suggest, among other things, a calling application which sends a function call and which is further adapted to act as a receiving application. Similarly, the cited art fails to teach or suggest a receiving application which can further act as a calling application. In other words, the cited art fails to teach an application which functions as both a calling and receiving application.

Instead, Ayabo appears to disclose a system in which multiple short message entities can send or receive fragmented data packages corresponding to a displayable message; however, the

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circuitry used to compose a displayable message for transmission is distinct from the circuitry used to receive and reconstruct a short message entity. (Col. 3, ln. 48-53). In particular, Ayabe appears to teach that a message composer provides a displayable message to a fragmenter, through a buffer. Thereafter, the fragmented message is passed to a packager and packages are sent out through a conveying network. (Col. 5, ln. 62 to col. 6, ln. 4; Fig. 2). On the receiving end, however, the different circuitry is used. In particular, the received packages are received from the conveying network and passed into a buffer. Thereafter the fragments are passed through a fragment retriever to a message reconstructor. Upon reconstruction of the message, the message is thereafter sent to a disposing device. (Col. 6, ln. 59 to col. 7, ln. 15, Fig. 3).

In other words, Ayabe merely teaches that packets corresponding to displayable messages are received and sent by means of different circuitry. Ayabe fails, however, to teach or suggest that any such circuitry is usable for receiving and sending messages, let alone a calling application that also functions as a receiving application as claimed. Accordingly, and for at least these reasons, Ayabe fails to teach or suggest the claimed invention, and particularly in combination with the other recited elements.

Applicants note that the Havinis reference also fails to compensate for the inadequacies of the Ayabe reference in this regard, inasmuch as it does not appear to teach or suggest a calling application which can also function as a receiving application (and vice versa). In fact, Havinis teaches only the origination of SMS or USSD messages which are sent to a serving network to report positioning by a mobile service. Havinis fails to teach that the mobile service also receives messages, let alone that such messages are received by an application which acts as both a calling and a receiving application, as claimed. Accordingly, and for at least these reasons, Applicants submit that independent claims 1, 20, 26, 28 and 30 are allowable over the cited art as the cited art fails to disclose or suggest a calling application which also acts as a receiving application, as claimed, and particularly in combination with the other recited elements.

It will be appreciated that because all independent claims are allowable over the cited references, each dependent claim is allowable over the cited art for at least the same reasons, and the other rejections and assertions of record with respect to the other dependent claims are now moot, and therefore need not be addressed individually. Nevertheless, to further differentiate between the cited references and the present invention, the new dependent claims will be specifically addressed.

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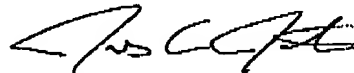
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With respect to dependent claims 37 and 38, the method further includes an act of the calling application receiving a delivery response for the first message as a whole (claim 37), and a short messaging layer which performs each of the acts of receiving the function call and dividing the first message (claim 38). Applicants submit that the cited art also fails to teach or suggest such limitations. For example, while Ayabe appears to teach that automatic negative acknowledgements are sent if one fragment does not arrive at a terminating entity, it fails to teach any response for a message as a whole, as claimed in claim 37. Further, Ayabe teaches performing various functions such as receiving a message, fragmenting a message, determining network capacity, and transmitting a message; however, such steps are completed by separate circuitry, including a capacity determiner, fragmenter, and packager. Accordingly, and for at least these reasons, claims 37 and 38 are also differentiated from, and allowable over, the cited art.

In view of the foregoing, it is respectfully submitted that all claims should now be found allowable over the art of record. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 2 day of December, 2005.

Respectfully submitted,



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